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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/756,257 11/25/96 SCHELLENBERG

J PII3248

PICKER INTERNATIONAL INC
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QM12/0717

EXAMINER

CASLER, B

ART UNIT

PAPER NUMBER

3737

DATE MAILED:

07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/756,257

Applicant(s)

SCHELLENBERG, JOHN D.

Examiner

Brian L Casler

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15,17,19-31 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,6-13,15,22,26 and 31 is/are allowed.
- 6) ☒ Claim(s) 3-5,17,19-21,23-25,27,28,30 and 33-35 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 17, 19-21, 23, 24, 25, 27-28, 30, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al. In view of Yabe.

Manwaring et al. teaches everything including a method and apparatus for guiding an instrument to a target within the body. Manwaring et al. teaches guiding a probe such as an endoscope along a selected trajectory to the target. The system in Manwaring et al. includes a display for indicating the orientation and position of the probe, the desired position with respect to the selected trajectory, and a direction in which the probe should be moved to return to the selected trajectory. The system includes the use of a number of known types of sensors to detect the position and orientation of the probe such as infrared, acoustic, or mechanical. The probe also includes the ability to take live forward-looking video images from the tip of the probe which may be included in the display. It is also important in Manwaring et al. that the display be located so that its visually presented information is conveniently viewed by the surgeon. Please note col. 3, lines 24-36, col. 4, lines 1-67, col. 6, lines 23-35, cols. 7-8, lines 64-67 and 1-9 respectively as well as figs. 1-2.

Manwaring et al. does not teach a display means mounted to the probe or determining the location of the display means.

Yabe teaches an endoscope system for getting biopsy information in which the endoscope includes a monitor for displaying live video images from the tip of the endoscope. Note col. 2, lines 22-68 and fig. 1.

In view of Yabe, it is well known to include on an endoscope itself a monitor to display live video images of the inside of the body wherein the images are conveniently viewable by a surgeon during a procedure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the endoscope of Yabe with the system of Manwaring et al. to allow the information regarding the position, orientation, and trajectory of the endoscope be displayed on the endoscope itself where it may be conveniently viewed by the surgeon while guiding the endoscope along the selected trajectory.

Response to Arguments

Applicant's arguments filed 5/8/00 have been fully considered but they are not persuasive.

Applicants added language regarding the rotationally invariant indication of position provided by the indicator on the tool and language regarding the operation of the display. Applicant argues that the applied prior art references do not provide the same function.

It is the examiner's position that applicant's added language does not provide a structural limitation of the device but states the intended use and operation of the device.

A recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Yanush, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); In re Finsterwalder, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); Ex parte Masham, 2 USPQ2d 1647 (BdPatApp & Inter 1987).

It is not clear in the claim what structural limitation enables the display to provide a rotationally invariant indication of position.

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Allowable Subject Matter

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1,6-13,15,22,26, and 31 are allowed.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L Casler whose telephone number is 703-308-3552. The examiner can normally be reached on days M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703-308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Brian L Casler
Primary Examiner
Art Unit 3737

blc
July 15, 2000